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22827 7590 11/12/2009 DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			EXAMINER PANDYA, SUNT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,555

Applicant(s)

ROBB, ARTHUR S.

Examiner

SUNIT PANDYA

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/10/09 has been entered.

Response to Amendment

This action is in response to amendments filed on 8/10/09, wherein the examiner acknowledges that claims 1, 14 & 18 have been amended, no claims have been added or canceled; consequently claims 1-20 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caro et al. (US Patent Pub. 2003/0050109), in view of Mullins (US Patent 5,158,293).

Caro et al. discloses a method of conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof). The disclosed method comprises:

receiving a base wagering game entry and a base wagering game wager from a player, wherein the base game comprises of set of number either selected by the player or are randomly generated, as player's entry in to the base wagering game (paragraphs [0041-0044]);

receiving an instant win game wager from the player (paragraphs [0041], [0042] and [0045]);

storing a game theme indicator (paragraphs [0041], [0045], [0046] and [0056] wherein memory 22 stores a theme indicator in the form of the type or name of the instant win game selected by the player);

storing a plurality of instant win game outcome display themes (paragraphs [0041], [0045] and [0046] wherein memory 22 stores a plurality of instant win game outcome display themes, e.g., Pick 3 and Pick 4, detailed in Figures 3A and 3B along with the related description thereof);

separately generating a second set of game indicia, which is the player's entry into the instant win game, that is different from the first set of game indicia for play of the instant win game, and determining and displaying an outcome of the instant win game for the player based on the second set of game indicia ([0049])

the outcome being displayed with one of the plurality of instant win game outcome display themes wherein the one of the plurality of instant win game outcome

display themes corresponds to the stored game theme indicator and the base wagering game (paragraph [0049] and Figures 3A and 3B along with the related description thereof); and

awarding the player an instant win game prize corresponding to the outcome of the instant win game (paragraph [0049] and Figures 3A and 3B along with the related description thereof).

However Caro et al. fails to disclose the instant win game being independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia, and that the theme of the instant win game is different from the theme of the base game. In a related gaming method, Mullins teaches a lottery game which includes an instant game and lottery jackpot (column 2, lines 30-33). The instant game includes allowing players to instantly win monetary prizes (Figure 2, element 23 and column 3, line 13-18), and the lottery jackpot allows for providing players with numbers, which are then randomly drawn to declare a winner (column 3, lines 56-64). Furthermore, Mullins also teaches the theme of the instant win game is different from the theme of the base game (Figures 1 & 2, and columns 2-3, lines 30-35, 54-18, wherein different themes for base game and for bonus/instant win game are taught). It would have been obvious to incorporate the lottery game as taught by Caro et al. into the gaming method taught by Mullins in order to allow players to increase their winnings as well as increasing players' interest in the games by implementing different awards and themes in the game.

Regarding claim 2, the combination of Caro et al. and Mullins teach that the instant win game and base wagering game are implemented in a gaming system having a host computer (Caro et al. computer 20) communicatively linked to a plurality of terminal units (Caro et al. terminals 16) and that the method further comprises receiving the base wagering game entry, the base wagering game wager and the instant win game wager at one of the terminal units (Caro et al. terminals 16). See Figure 1 along with the related description thereof and paragraph [0040].

Regarding claim 3, the combination of Caro et al. and Mullins teaches determining the outcome of the instant win game for the player at one of the host computer (Caro et al. computer 20) and terminal units (terminals 16) receiving the base wagering game entry, the base wagering game wager and the instant win game wager (paragraph [0049] wherein the computer 20 calculates matches and records results and prizes associated with each ticket 12).

Regarding claim 4, the combination of Caro et al. and Mullins teaches displaying the outcome of the instant win game to the player at one of the terminal units (Caro et al. terminals 16) receiving the base wagering game entry, the base wagering game wager and the instant win game wager (paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes).

Regarding claim 5, the combination of Caro et al. and Mullins teaches that each terminal unit (Caro et al. terminal 16) includes a ticket printer (Caro et al. paragraph [0040], wherein the terminal 16 print tickets 12) and that the method further comprises printing a ticket (ticket 12) at the printer of one of the terminal units (Caro et al. terminals

16), wherein the ticket includes first set of game indicia corresponding to the base wagering game entry and base wagering game wager (Caro et al. indicia 26-3A and Figures 3A and 3B along with the related description thereof) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Caro et al. Figures 3A and 3B along with the related description thereof).

Regarding claim 6, the combination of Caro et al. and Mullins teaches that each terminal unit (Caro et al. terminal 16) includes a video display device (Caro et al. paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (Caro et al. terminals 16), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Caro et al. Figures 3A, 3B.along with the related description thereof).

Regarding claim 7, the combination of Caro et al. and Mullins teaches that the instant win game and base wagering game are implemented in a gaming system having a host computer (Caro et al. computer 20) communicatively linked to a plurality of terminal units (Caro et al. terminals 16) and that the method further comprises storing the game theme indicator at one of the host computer (Caro et al. computer 20) and the terminal units (Caro et al. terminals 16). See Caro et al. paragraphs [0041], [0045] and [0046] and Figure 1 along with the related description thereof, wherein computer 20

includes memory 22 which stores a theme indicator in the form of the type or name of the instant win game selected by the player and stores a plurality of instant win game outcome display themes, e.g., Pick 3 and Pick 4, detailed in Figures 3A and 3B along with the related description thereof.

Regarding claim 8, the combination of Caro et al. and Mullins teaches that the instant win game and base wagering game are implemented in a gaming system having a host computer (Caro et al. computer 20) communicatively linked to a plurality of terminal units (Caro et al. terminals 16) and that the method further comprises storing the plurality of instant win game outcome display themes at the terminal units (Caro et al. terminals 16 and paragraph [0041]). See Caro et al. paragraph [0040] wherein terminal 16 is a point-of-sale terminal or a computer. Computers inherently include a processor and a data storage device or memory. The instant win game outcome display themes, e.g., Pick 3 or Pick 4 of Figures 3A and 3B, are communicated from the computer 20 to the terminal 16 (paragraph [0020]) and at least temporarily stored in a memory of the terminal 16 and processed by a processor of the terminal 16 prior to display or printing for the player.

Regarding claim 10, the combination of Caro et al. and Mullins teaches that the instant win game and base wagering game are implemented in a gaming system having a host computer (Caro et al. computer 20) communicatively linked to a plurality of terminal units (Caro et al. terminals 16) and that the method further comprises receiving the base wagering game entry, the base wagering game wager and the instant win game wager at the input device of the terminal (Caro et al. paragraphs [0020] and

[0040] wherein player selections made at the terminal 16 are transmitted to the computer 20).

Regarding claim 11, the combination of Caro et al. and Mullins teaches that each terminal unit (Caro et al. terminal 16) includes a ticket printer (Caro et al. paragraph [0040], wherein the terminal 16 print tickets 12) and that the method further comprises printing a ticket (Caro et al. ticket 12) at the printer of one of the terminal units (Caro et al. terminals 16), wherein the ticket includes first set of game indicia corresponding to the base wagering game entry and base wagering game wager (Caro et al. indicia 26-3A and Figures 3A and 3B along with the related description thereof) and second set of game indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Caro et al. Figures 3A and 3B along with the related description thereof).

Regarding claim 12, the combination of Caro et al. and Mullins teaches that each terminal unit (Caro et al. terminal 16) includes a video display device (Caro et al. paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (Caro et al. terminals 16), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Caro et al. Figures 3A, 3B along with the related description thereof).

Regarding claims 9 and 13, the combination of Caro et al. and Mullins teaches a game system including dispensing the instant win game prize to the player via a value dispensing unit (Caro et al. step 262 of Figure 4 and step 318 of Figure 5 along with the related descriptions thereof wherein controller 100 in gaming unit 20 dispenses value to the player based on the game outcome) at the terminal (gaming unit 20). Caro et al. also discloses dispensing value to the player, based on the instant win game outcome.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt et al. (US Patent 5,398,932), in view of Caro et al. and Mullins.

Eberhardt et al. discloses a gaming system having a plurality of terminal units and a host computer operatively coupled to the terminal units (Figure 1 along with the related description thereof discloses plurality of terminals and host computer in communication with the terminals and column 4, lines 26-50) over a network to effect play of a lottery game. Eberhardt et al. discloses that different lottery games can be provided by the gaming system. However, Eberhardt et al. does not explicitly disclose providing a lottery game that includes a base game and an instant win game. In a related gaming system, Caro et al. teaches a lottery game employed over a network for

effecting play of a lottery game having a base game and an instant win game. Caro et al. teaches a lottery game having a base game and an instant win game increases player interest in the game by allowing players to select numbers as in a draw lottery while also receiving immediate results as in an instant win game (paragraphs [0009], [0010] and [0011]). It would have been obvious to incorporate the lottery game as taught by Caro et al. into the gaming system disclosed by Eberhardt et al. in order to increase player interest, in the game of Eberhardt et al. by providing a lottery game having a base game and an instant win game as desirably taught by Caro et al. in paragraphs [0009], [0010] and [0011]). Thus, the combination of Eberhardt et al. and Caro et al. teach a game system for conducting an instant win game in combination with a base wagering game over a network, wherein the computer 22, 32 of Eberhardt et al. would be programmed to perform the functions of host computer 20 of Caro et al. and wherein the gaming units 20 of Eberhardt et al. would be programmed to perform the functions of the terminal units 16 of Caro et al.

Regarding claim 14, the combination of Eberhardt et al. and Caro et al. teach a game system for conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof in Eberhardt et al.). The game system comprises:

a plurality of terminal units (gaming units 3) and a host computer (element 2), including a memory and a controller, operatively coupled to the terminal units (gaming units 3). Each terminal unit (gaming unit 3) comprises: an input device that allows a

player to make a plurality of input selections (control panel 40 of Figure 1 along with the related description thereof);

a terminal unit memory device;

a currency accepting mechanism that is capable of allowing the player to deposit a medium of currency (column 5, lines 6-20);

a value-dispensing mechanism that is capable of dispensing value to the player (column 5, lines 6-20, discloses value dispensing mechanism inform of tickets that are provided to players);

an output device (ticket printer 43, display 42 and Figure 1 along with the related description thereof); and

a terminal controller (controller 3 Figure 1 along with the related description thereof) operatively coupled to the display unit, the input device, the terminal unit memory device, the currency accepting mechanism, the value-dispensing mechanism, and the output device,

wherein the terminal unit controller (controller 3) is programmed to allow a player to enter a base wagering game entry at the input device and to allow a player to make a base wagering game wager and an instant win game wager at the currency accepting mechanism (paragraphs [0042] and [0045] of Caro et al. wherein a player can place separate wagers for the base game and the instant win game),

wherein the terminal unit controller (controller 3 Figure 1) is programmed to store a game theme indicator at a corresponding terminal unit (gaming unit 3 and also see Caro et al. paragraph [0041]), wherein the terminal unit controller (MP 104) is

programmed to store a plurality of instant win game outcome display themes at the terminal unit memory device (memory 106 and also see Caro et al. paragraph [0041]),

wherein the terminal unit controller is programmed to separately generating a second set of game indicia, as player's entry for the instant win game (Caro et al. [0040]) that is different from the first set of game indicia for play of the instant win game, and determining and displaying an outcome of the instant win game for the player based on the second set of game indicia such that the instant win game is independent from the base wagering game entry (see Caro et al. paragraph [0049]);

wherein the terminal unit controller (controller 40) is programmed to display the outcome of the instant win game at the output device (display 42) with the outcome being displayed with one of the plurality of instant win game outcome display themes corresponding to the game theme indicator and the base game, and

wherein the terminal unit controller (controller 40) is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

However the combination of Eberhardt et al. and Caro et al. fails to disclose that the instant win game being independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia, and that the theme of the instant win game is different from the theme of the base game. In a related gaming method, Mullins teaches a lottery game which includes an instant game and lottery jackpot (column 2, lines 30-33). The instant game includes allowing players to instantly win monetary prizes (Figure 2, element 23 and column 3, line 13-18), and the lottery

jackpot allows for providing players with numbers, which are then randomly drawn to declare a winner (column 3, lines 56-64). Furthermore, Mullins also teaches the theme of the instant win game is different from the theme of the base game (Figures 1 & 2, and columns 2-3, lines 30-35, 54-18, wherein different themes for base game and for bonus/instant win game are taught). It would have been obvious for one with ordinary skill in the art at the time of the invention to implement different themes between the base game and bonus game, as taught by Mullins, into a game machine taught by combination of Eberhardt et al. and Caro et al., to allow players to increase their winnings as well as increasing players' interest in the game.

Regarding claim 15, the combination of Eberhardt et al. , Caro et al. and Mullins teach that each terminal unit (gaming unit 3) includes a ticket printer (printer 43) and that the method further comprises printing a ticket (ticket 12 of Caro et al. as shown in Figures 3A and 3B along with the related description thereof) at the printer (printer 56) of one of the terminal units (gaming units 3), wherein the ticket includes first indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof in Caro et al.) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof in Caro et al.).

Regarding claim 16, the combination of Eberhardt et al. , Caro et al. and Mullins teach that each terminal unit (gaming unit 3) includes a video display device (display 42)

and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (gaming units 2), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof describe tickets 12 in Caro et al. that would be displayed on display 42 in the gaming system taught by Eberhardt et al.).

Regarding claim 17, the combination of Eberhardt et al. , Caro et al. and Mullins teach that the host computer controller (host computer 2) determines the outcome of the instant win game and stores the game theme indicator at the memory and wherein the terminal controller (gaming unit 3) stores a plurality of instant win game outcome themes at the terminal memory and transmits the outcome of the instant win game and the game theme indicator to the terminal unit (gaming unit 3).

Regarding claim 18, the combination of Eberhardt et al. and Caro et al. teach a terminal unit (gaming unit 3) for conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof in Eberhardt et al.). The disclosed terminal unit (gaming unit 3) comprises:

- an input device that allows a player to make a plurality of input selections (Figure 1 along with the related description thereof);

- a terminal unit memory device (Figure 3 along with the related description thereof;

a currency accepting mechanism that is capable of allowing the player to deposit a medium of currency (coin acceptor and bill acceptor of Figure 1 along with the related description thereof);

a value-dispensing mechanism that is capable of dispensing value to the player (Figure 1 along with the related descriptions thereof wherein controller in gaming unit dispenses value to the player based on the game outcome);

an output device (ticket printer 43, display 42 and Figure 1 along with the related description thereof); and

a controller (controller 3 of Figure 1 along with the related description thereof) operatively coupled to an output unit, the input device, the terminal unit memory device, the currency accepting mechanism, the value-dispensing mechanism, and the output device,

wherein the controller (controller 3) is programmed to allow a player to enter a base wagering game entry at the input device, wherein either the player can select the indicia or can be randomly generated and to allow a player to make a base wagering game wager and an instant win game wager at the currency accepting mechanism (paragraphs [0042] and [0045] of Caro et al. wherein a player can place separate wagers for the base game and the instant win game),

wherein the controller (controller 3) is programmed to store a game theme indicator at a corresponding terminal unit (gaming unit 20 and also see Caro et al. paragraph [0041]),

wherein the controller (controller 3) is programmed to store a plurality of instant win game outcome display themes at the terminal unit memory device (memory 106 also see Caro paragraph [0041]),

wherein the controller (controller 3) is programmed to separately generating a second set of game indicia, as player's entry to play the instant win game, that is different from the first set of game indicia for play of the instant win game, and determining and displaying an outcome of the instant win game for the player based on the second set of game indicia such that the instant win game is independent from the base wagering game entry (see Caro et al. paragraph [0049]);

wherein the controller (controller 3) is programmed to display the outcome of the instant win game at the output device (display 42) with the outcome being displayed with one of the plurality of instant win game outcome display themes corresponding to the game theme indicator and the base game entry, and

wherein the controller (controller 3) is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

However the combination of Eberhardt et al. and Caro et al. fails to disclose that the instant win game being independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia, and that the theme of the instant win game is different from the theme of the base game. In a related gaming method, Mullins teaches a lottery game which includes an instant game and lottery jackpot (column 2, lines 30-33). The instant game includes allowing players to instantly

win monetary prizes (Figure 2, element 23 and column 3, line 13-18), and the lottery jackpot allows for providing players with numbers, which are then randomly drawn to declare a winner (column 3, lines 56-64). Furthermore, Mullins also teaches the theme of the instant win game is different from the theme of the base game (Figures 1 & 2, and columns 2-3, lines 30-35, 54-18, wherein different themes for base game and for bonus/instant win game are taught). It would have been obvious for one with ordinary skill in the art at the time of the invention to implement different themes between the base game and bonus game, as taught by Mullins, into a game machine taught by combination of Eberhardt et al. and Caro et al., to allow players to increase their winnings as well as increasing players' interest in the game.

Regarding claim 19, the combination of Eberhardt et al., Caro et al. and Mullins teach that each terminal unit (gaming unit 3) includes a ticket printer (printer 43) and that the method further comprises printing a ticket (ticket 12 of Caro et al. as shown in Figures 3A and 3B along with the related description thereof) at the printer (printer 43 of one of the terminal units (gaming units 3), wherein the ticket includes first set of game indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof in Caro et al.) and second set of game indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof in Caro et al.).

Regarding claim 20, the combination of Eberhardt et al., Caro et al. and Mullins teach that each terminal unit (gaming unit 3) includes a video display device (display 42) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (gaming units 3), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof describe tickets 12 in Caro et al. that would be displayed on display 42 in the gaming system taught by Eberhardt et al.).

Response to Arguments

Applicant's arguments, filed on 8/10/09, with respect to the rejection(s) of claim(s) 1 under 35 U.S.C 101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Applicant's arguments with respect to claims 1-20 have been considered but they are not persuasive.

Regarding the applicant's arguments on page 17 that the concept number 30 from Caro et al. figure 2A is not the player's entry in the instant win game, the examiner respectfully disagrees. The set of numbers taught by Caro et al., is considered player's entry because player is utilizing those numbers to play the instant win game. Thus, the concept number 30 of figure 2A of Caro et al., constitutes as player's entry in the instant

win game, similar to element 26, which is player's entry to play the base wagering game.

Regarding the applicant's arguments on page 18 that the reference of Caro et al. does not include two distinct set of indicia, the examiner respectfully disagrees. Caro et al., in figure 2A, clearly shows two distinct sets of indicia, elements 26 & 30, which are independent of each other. In paragraphs 47 - 49, Caro et al. further discloses of multiple indicia, wherein indicia one is used for an instant win game and indicia two is for lottery play. Furthermore, the independent claim 1 calls for generating first set of indicia as player's entry for the base wagering game, and a separate second set of game indicia different from the first set of game indicia as player's entry in the instant win game, disclosed by Caro et al. in figure 2A element 30, which is generated independent of the base wagering game.

Regarding the applicant's argument on page 13 that Caro et al. fails to disclose that the outcome for the instant win game is independent of the base wagering game, and is not dependent upon or a function of the first set of game indicia, the examiner agrees with the applicant. However Mullins teaches the features lacking by Caro et al. Mullins teaches the instant win game being independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia, and that the theme of the instant win game is different from the theme of the base game. Mullins teaches a lottery game which includes an instant wing game and lottery jackpot (column 2, lines 30-33), wherein the instant game includes allowing players to instantly win monetary prizes (Figure 2, element 23 and column 3, line 13-18), and the lottery jackpot

allows providing players with numbers, which are then randomly drawn to declare a winner (column 3, lines 56-64). As noted above, the independent claim 1, is rejected using the combination of Caro et al. and Mullins, thus, when taken as a whole, the combination of Caro et al. Mullins teach all the limitations recited in the independent claims 1.

Applicant's arguments with respect to claims 1-20 have been considered but deemed non-persuasive, consequently the rejection is maintained.

The examiner would also like to point out, that in the rejection above, the examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIT PANDYA whose telephone number is (571)272-2823. The examiner can normally be reached on M-Th 8 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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